

## REMARKS

Reconsideration of this application, as amended, is respectfully requested.

Initially, the Applicants would like to thank the Examiner for the continued indication that claims 7, 9, 13, 15, 20, 22 and 26 are allowed.

In the Official Action, the Examiner rejects claims 1-6, 8, 10-12, 14, 16-19, 21, 23-25 and 27-34 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner argues that claims 1, 27 and 20 recite the limitation of the ball joint axis being parallel to the instrument axis rendering the claim indefinite as the instrument axis is not fixed due to the ability to incline as well as rotate with the ball joint.

In response, Applicants respectfully traverse the Examiner's rejection under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph, for at least the reasons set forth below.

In the medical instrument holding apparatus of claims 1, 27 and 30, the ball joint axis originates from the supporting mechanism (which is adapted to support the medical instrument) and has a structure in which a ball is arranged at its end. Thus, the relationship between the ball joint axis and the medical instrument (e.g., endoscope) axis is always fixed. That is, although the medical instrument axis is not fixed in space, it is fixed with respect to the ball joint axis.

Accordingly, it is respectfully requested that the rejection of claims 1-6, 8, 10-12, 14, 16-19, 21, 23-25 and 27-34 under 35 U.S.C. § 112, second paragraph, be withdrawn.

In the Official Action, the Examiner again rejects claims 1-6, 8, 10-12, 14, 16-19, 21, 23-25 and 27-34 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent

Application Publication No. 2001/0027313 to Shimmura et al., (hereinafter “Shimmura”) in view of U.S. Patent No. 5,957,423 to Kronner (hereinafter “Kronner”).

In response, Applicants respectfully traverse the Examiner’s rejection under 35 U.S.C. § 103(a) for at least the reasons set forth below.

Applicants respectfully submit that Shimmura and Kronner, whether taken individually or in combination, do not disclose the ball joint configuration recited in independent claims 1, 27 and 30.

Claims 1, 27 and 30 recite that the ball joint is “located between the moving mechanism and the supporting mechanism.” Therefore, since the link mechanism (5) is considered to be at least a part of the moving mechanism, only the portion below the ball joint in Figure 7 of Shimmura can be considered to be the supporting mechanism and holding portion (see attached explanatory Figure enclosed herewith)(such explanatory Figure is not a replacement Figure and is not indicated as such, it is only enclosed to assist the Examiner in the understanding of the Shimmura reference as it relates to the invention recited in claims 1, 17 and 30). That is, since the ball joint must be located between the moving mechanism and the supporting mechanism, the portions identified with reference numerals 12, 13 and 17 in Figure 17 of Shimmura must be considered to be the supporting mechanism and holding portion.

Claims 1, 27 and 30 further recite that the ball joint supports “the supporting mechanism from below the supporting mechanism in the direction of gravity.” Thus, the portion of the device of Figure 7 of Shimmura (and each of the other embodiments of Shimmura) that can only be considered to be the supporting mechanism is not supported from below by the ball joint (in the direction of gravity). In other words, the ball joint of Figure 7 of

Shimmura supports the portion of Shimmura that can only be considered to be the supporting mechanism from above in the direction of gravity (not below as is recited in claims 1, 27 and 30). There is no suggestion in Shimmura that the ball joint can be configured to be below the supporting mechanism. The Kronner reference does not cure the deficiencies of Shimmura.

Thus, the medical instrument holding apparatus recited in claims 1, 27 and 30 patentably distinguish over the cited references for at least such reasons.

With regard to the rejection of claims 1-6, 8, 10-12, 14, 16-19, 21, 23-25 and 27-34 under 35 U.S.C. § 103(a), independent claims 1, 27 and 30 are not rendered obvious by the cited references because neither the Shimmura patent application nor the Kronner patent, whether taken alone or in combination, teach or suggest a medical instrument holding apparatus having the features discussed above and recited in independent claims 1, 27 and 30. Accordingly, claims 1, 27 and 30 patentably distinguish over the prior art and are allowable. Claims 2-6, 10-12, 14, 16-19, 21, 23-25, 28, 29, 31 and 32 being dependent upon claims 1, 27 and 30, are thus at least allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 1-6, 8, 10-12, 14, 16-19, 21, 23-25 and 27-34 under 35 U.S.C. § 103(a).

Furthermore, new claim 35 has been added to further define the patentable invention. New claim 35 is fully supported in the original disclosure. Thus, no new matter has been entered into the disclosure by way of the addition of new claim 35. Applicants respectfully submit that new claim 35 patentably distinguishes over the prior art for the reasons set forth above with regard to claims 1, 27 and 30 and at least further because new claim 35 recites that the ball joint is provided in a position shifted from a center of gravity of

the holding portion along a longitudinal axis of the second side of the moving mechanism.

Shimmura and Kronner simply do not disclose or suggest such a feature.

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicants' attorney would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



Paul J. Esatto, Jr.

Registration No. 30,749

Scully, Scott, Murphy & Presser, P.C.  
400 Garden City Plaza, Ste. 300  
Garden City, New York 11530  
(516) 742-4343  
TS:cm